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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,500	06/19/2001	L. Douglas Everhart	53470.003038	8689

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EXAMINER

STORK, KYLE R

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/883,500	EVERHART ET AL.	
	Examiner	Art Unit	
	Kyle R Stork	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>19.6.01, 26.10.02</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2178

DETAILED ACTION

1. This office action is in response to the application filed 19 June 2001 and the information disclosure statements filed 19 June 2001 and 26 September 2002.
2. Claims 1-20 are pending. Claims 1, 6, 11, and 16 are independent claims.

Information Disclosure Statement

3. The information disclosure statements (IDS) submitted on 19 June 2001 and 26 September 2002 were filed and are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Section 2106 of the MPEP states:

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se
Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines

Art Unit: 2178

structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

(b) Nonfunctional Descriptive Material

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided.

Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).)

The policy that precludes the patenting of nonfunctional descriptive material would be easily frustrated if the same descriptive material could be patented when claimed as an article of manufacture. For example, music is commonly sold to consumers in the format of a compact disc. In such cases, the known compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture.

Office personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

Claims 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per independent claim 16, the applicant discloses "a nested prompt object."

This data structure is not embodied in a computer-readable medium and is descriptive

Art Unit: 2178

per se. Furthermore, the claims are directed to "non-functional descriptive material."

This renders the claim non-statutory.

Claims 17-20 are rejected due to their dependency upon a rejected base claim.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Yost et al. (US 6154766)

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As per independent claim 1, Yost discloses a reporting system for creating a report wherein the report may specify one or more prompt objects as properties of the report comprising:

- An inner prompt object comprising a first question to be asked of a user and at least one validation property (Figure 3, item 116; column 10, lines 62-67: Here,

the service to be monitored is the first question, which is validated by the user identifying one of the services from the object browser or service queue.)

- An outer prompt object comprising a second question to be asked of a user and at least one validation property (Figure 3, item 118; column 11, lines 1-17: Here, the type of service is the second question, which is validated by the user selecting from either scheduled service or alert service.)
- Wherein the inner prompt object is nested within the outer prompt object (Figure 3)

As per dependent claim 2, Yost discloses the system further comprising:

- A first answer provided by a user to the first question of the inner prompt object (column 10, lines 62-67)
- A second answer provided by a user to the second of the outer prompt object (column 11, lines 1-17)

As per dependent claim 3, Yost discloses the system wherein the first answer to the first question of the inner prompt serves as a validation property to the second answer to the second question of the outer prompt (column 12, lines 6-14: Here, the user has the choice of having the personal settings stored in order to update preferences at a later time. These stored properties would then become the default validation properties when a user subscribed to or cancelled existing services).

As per dependent claim 4, Yost discloses the system wherein the inner and outer prompt objects are embedded in a draft prompt (Figure 3: Here, the item 116 is the inner prompt while item 118 is the outer prompt. These items are further embedded in

Art Unit: 2178

the draft prompt that contains prompts for selecting duration, schedule, content, and personalization).

As per dependent claim 5, Yost discloses the system wherein the inner prompt is used as part of a definition of a plurality of outer prompts (column 12, lines 6-14: Here, the answer to the inner prompt is used in the personalization of content for item 124).

As per independent claim 6, Yost discloses the method of creating a report to be executed on a reporting system comprising the steps of:

- Selecting a template with one or more template properties (column 6, lines 34-45)
- Selecting a filter with one or more filter properties (column 6, lines 34-45)
- Specifying one or more of the template or filter properties with an inner prompt object and an outer prompt object (column 6, lines 34-45)

The applicant further recites the limitations similar to those disclosed in claim 1. Claim 6 is similarly rejected under Yost.

As per dependent claim 7, the applicant discloses the limitations similar to those disclosed in claim 2. Claim 7 is similarly rejected under Yost.

As per dependent claim 8, the applicant discloses the limitations similar to those disclosed in claim 3. Claim 8 is similarly rejected under Yost.

As per dependent claim 9, the applicant discloses the limitations similar to those disclosed in claim 4. Claim 9 is similarly rejected under Yost.

As per dependent claim 10, the applicant discloses the limitations similar to those disclosed in claim 5. Claim 10 is similarly rejected under Yost.

Art Unit: 2178

As per independent claim 11, the applicant discloses the processor-readable medium comprising code for execution by a processor of the method of claim 6. Claim 11 is similarly rejected under Yost.

As per dependent claim 12, the applicant discloses the processor-readable medium comprising code for execution by a processor of the method of claim 7. Claim 12 is similarly rejected under Yost.

As per dependent claim 13, the applicant discloses the processor-readable medium comprising code for execution by a processor of the method of claim 8. Claim 13 is similarly rejected under Yost.

As per dependent claim 14, the applicant discloses the processor-readable medium comprising code for execution by a processor of the method of claim 9. Claim 14 is similarly rejected under Yost.

As per dependent claim 15, the applicant discloses the processor-readable medium comprising code for execution by a processor of the method of claim 10. Claim 15 is similarly rejected under Yost.

As per independent claim 16, the applicant discloses the processor-readable medium comprising code for execution by a processor of the method of claim 1. Claim 16 is similarly rejected under Yost.

As per dependent claim 17, the applicant discloses the processor-readable medium comprising code for execution by a processor of the method of claim 2. Claim 17 is similarly rejected under Yost.

Art Unit: 2178

As per dependent claim 18, the applicant discloses the processor-readable medium comprising code for execution by a processor of the method of claim 3. Claim 18 is similarly rejected under Yost.

As per dependent claim 19, the applicant discloses the processor-readable medium comprising code for execution by a processor of the method of claim 4. Claim 19 is similarly rejected under Yost.

As per dependent claim 20, the applicant discloses the processor-readable medium comprising code for execution by a processor of the method of claim 5. Claim 20 is similarly rejected under Yost.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Harrington (US 2004/0205643): Discloses document production using intent information.
- Berringer et al. (US 2004/0181756): Discloses creating and verifying documents.
- Katariya et al. (US 2003/079185): Discloses generating a document summary.
- Chen et al. (US 2003/0023639): Discloses a generator for creating web pages.
- Davis et al. (US 2002/0188633): Discloses generating HTML using templates and cached files.
- Berg et al. (US 2002/0184264): Discloses synchronizing an XML document with its object model.

Art Unit: 2178

- Bell et al. (US 2002/0138527): Discloses web-based venture reporting.
- Schubert, Jr. et al. (US 2002/0069230): Discloses a management system for reporting document information.
- Kupiec (US 6533822): Discloses creating summaries with indicators.
- Ishikawa et al. (US 6338034): Discloses generating a summary of a document.
- Evans (US 6226631): Discloses submitting search queries.
- Tripathi et al. (US 5832504): Discloses report generation system.
- Clapp (US 5313394): Discloses document assembly customization system.
- Kyle et al. (US 2001/0032215): Discloses a system for completing forms.
- Underwood et al. (US 6697825): Discloses generating multiple instances of elements of a web site.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (703) 308-5465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle Stork
Patent Examiner
Art Unit 2178



STEPHEN S. HONG
PRIMARY EXAMINER